

REMARKS

The present application includes pending claims 1, 3-4, and 8-28. Claims 8-16 have been withdrawn. Claims 1, 3-4, and 17-26 have been rejected, while claims 27 and 28 have been allowed. By this Amendment, claim 20 has been amended as set forth above. It is respectfully submitted that the pending claims define allowable subject matter.

Claims 1 and 17 stand rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,234,051 ("Bareggi"). Claims 3 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bareggi in view of United States Patent No. 5,574,104 (Kolycheck). Claims 18, 20, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 4,403,533 (Cox) in view of Kolycheck and United States Patent No. 6,050,167 (Wilhite). Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Kolycheck, Wilhite and United States Patent No. 5,820,006 (Turner). Claims 21-24 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Kolycheck, Wilhite, and Bareggi. The Applicants respectfully traverse these rejections at least for the reasons set forth previously during prosecution, and for the reasons set forth hereafter.

The Applicants first turn to the rejection of claims 1 and 17 as being anticipated by Bareggi. The Office Action notes that the "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art." *See* January 26, 2005 Office Action at page 5. The Applicants respectfully submit that the claims of the present application are structurally different than the screwing tool shown in Bareggi, as discussed below.

Claim 1 recites, in part, a “slotted plate having upper and lower panel engaging surfaces **defining a recess of approximately the same width and thickness as said glass panel to be separated.**” Such a slotted plate is shown, for example, in Figure 4 of the present application. The slotted plate shown in Figure 4 is approximately the same width of the glass panel to be separated. The screwing machine of Bareggi, however, is clearly not the same width of a glass panel to be separated. Instead, the screwing machine of Bareggi shows a screw engaging member 20” (i.e., insert 20”). The size and shape of a screw is substantially different than those of a glass panel. A screw is much smaller than a glass panel. A component that is adapted to the size and shape of a screw, such as insert 20”, will be much smaller than a glass panel. Thus, the structure of the component that is adapted to the size and shape of a screw cannot be approximately the same width and thickness of a glass panel.

The insert member 20” is sized to engage a screw or bolt member. Clearly, a screw or bolt is substantially smaller than a glass panel. Because the insert 20” is configured to engage a screw or bolt (and **not** a glass panel), it is configured according to the size of the screw or bolt, as clearly shown in Figure 1 of Bareggi. Thus, the insert 20” does not define a “recess that is approximately the same width and thickness as said glass panel to be separated,” as recited, for example, in claim 1.

The invention recited in claim 1 recites a slotted plate having a specific structure, i.e., a recess that is approximately the same width and thickness as said glass panel to be separated, which is clearly not taught or suggested by the screw engaging insert 20” of Bareggi. Thus, claim 1 is structurally different than the screwing machine of Bareggi. At least for this reason,

the Applicants respectfully submit that Bareggi does not anticipate claim 1, or the claims that depend from claim 1.

The Applicants also respectfully submit that the screwing machine described in Bareggi is not capable of performing the intended use of claim 1. As discussed at length, Bareggi discloses a “screwing machine,” but not a glass separating device. In particular, Bareggi “relates to tools used for **controlled tightening** of mechanical members, typically **screwed**.” *Id.* at column 1, lines 5-6 (emphasis added). Figure 1 of Bareggi shows the screwing tool.

FIG. 1 shows a manually operated dynamometric wrench for **screwing screws or nuts** and consisting of a grippable body 10 on which is mounted a housing 11 designed to contain a data processing unit.

Id. at column 2, lines 56-59 (emphasis added).

To the arm 10 can be connected removably and alternatively connectable inserts 20, 20' and 20'' of which the insert 20' is shown mounted and the other two replaceable are shown in exploded view.

Id. at column 3, lines 8-11. The insert 20'' shown in Bareggi is configured to engage a screw, but not a glass panel. The insert 20'' resembles an operative end of a wrench. Attempting to precisely separate glass with the wrench-like insert 20'' would be extremely difficult, if not impossible. There is little chance that the glass panel could be separated at all, let alone precisely separated, through the use of a wrench-like insert 20''. Thus, the Applicants respectfully submit that Bareggi is incapable of performing the intended use of the claims of the present application.

The Office Action also asserts that “Bareggi teaches the force applied to the handle in a linear manner.” Notably, the Office Action offers no citation from Bareggi to support this assertion. In fact, it is impossible to offer support from Bareggi for this assertion, because Bareggi teaches away from a linear force. Bareggi discloses a “screwing machine.” In order to screw a fastener, the tool is rotated or turned, which is, by definition, not a linear movement. “[T]he term **screwing device** is used for simplicity of exposition in its broad general sense of device designed to acts on a mechanical member to **turn it.**” *Id.* at column 1, lines 16-18 (emphasis added). Thus, the Applicants respectfully submit that Bareggi does not anticipate claim 17 at least for this reason, and respectfully request reconsideration of the claim rejection.

The Applicants now turn to the rejection of claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Bareggi in view of Kolycheck. The Applicants respectfully submit that claims 3 and 4 should be in condition for allowance, at least for the reasons set forth above.

Next, the Applicants turn to the rejection of claims 18, 20, and 25 under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Kolycheck and Wilhite. The Office Action notes that the “motivation to combine Kolycheck can be found in col. 1, lines 46-52.” *See* January 26, 2005 Office Action at page 6. The Office Action, however, does not provide a motivation to combine any other references to Cox.

With respect to the motivation to combine Kolycheck to Cox, column 1, lines 46-52 of Kolycheck states the following:

The need to control static charge buildup and dissipation often requires the total assembly environment to be constructed of partially conductive materials. It also may require electrostatic protective packages, tote boxes, casings, and covers be made from

conductive polymeric materials to store, ship, protect, or support electrical devices and equipment.

The Applicants respectfully submit, however, that there is nothing in this passage that would motivate one of ordinary skill in the art to combine Kolycheck with Cox. Cox relates to a slitter used for slitting elastic materials such as rubber. While Kolycheck relates to an electrostatic dissipating additive, there is absolutely nothing in Kolycheck that teaches, or suggests, any relevance in connection with a rubber slitter (i.e., the field of invention of Cox). Further, Kolycheck does not even remotely mention or suggest a glass separating tool. As such, the Applicants respectfully submit that there is nothing in Cox or Kolycheck that would lead one of ordinary skill in the art to combine the two references. Thus, the Applicants respectfully submit that the proposed combination is improper.

“The field of art to which [Cox] pertains is that of reinforced **elastic material**, particularly to the aligning and cutting of an elongate web of such a material into multiple strips.” *See Cox* at column 1, lines 5-8 (emphasis added). That is, Cox relates to a system and method of assembling radial tires.

In the method for aligning and slitting an elongate web or reinforced **elastic material** into parallel strips, the improvement includes the steps of aligning the web relative to either its longitudinal center line or one of its edges; keeping the web in a generally flat condition during the aligning step; and restraining the advancing means against lateral movement during the slitting step.

Id. at column 2, lines 36-42 (emphasis added). Notably, Cox does not relate to, nor does it teach or suggest, “a system configured to facilitate separating edge portions for a **glass panel**, in which the **glass panel** floats above a layer of electrostatic dissipative material.” Further, Kolycheck

does not teach, nor suggest, this limitation either. Instead, Kolycheck is related to an electrostatic dissipative polymeric composition. Further, Wilhite relates to a “saw table gauge block.” *See* Wilhite at Abstract. The saw table of Wilhite is used to saw wood, and other such materials, but is not suitable for separating edge portions of a glass panel. Thus, Cox, Kolycheck, or Wilhite, alone, or in combination with one another, do not teach, nor suggest, separating glass panel material. Further, Cox, Kolycheck and Wilhite represent three disparate fields of endeavor, and there is nothing in these references that would lead one of ordinary skill in the art to combine them together.

The Office Action also asserts that “Cox teaches a vacuum 146 configured to hold the glass panel tightly.” *See* Office Action at page 6. Cox, however, simply does not teach, nor suggest, separating glass. Rather, it relates to separating “elastic material,” as discussed above. The Applicants respectfully submit that there is absolutely nothing in Cox that deals with glass. Cox does not teach, nor suggest, “holding a glass panel tightly.” Thus, at least for this reason, claim 25 should be in condition for allowance.

The Applicants respectfully note that a citation among these references as to where such a limitation (i.e., holding a glass panel tightly) is taught was not provided in the Office Action. This limitation is not found in the references. Again, these references simply do not relate to separating glass. Nor do any of the references teach, or suggest, pumping nitrogen along an underside of a glass panel.

The Office Action also stated the following: “it is noted that the features upon which applicant relies (i.e., pumping *pure* nitrogen) are not recited in the rejected claim(s).” *Id.* at page 6. The Applicants have amended claim 20 as set forth above to recite “pure nitrogen.” The

Applicants respectfully submit that the proposed combination of references does not teach or suggest this limitation.

Moving on, the Applicants respectfully submit that the combination of Cox, Kolycheck, Wilhite and Turner does not render claim 19 of the present application unpatentable, at least for the reasons discussed above and previously during prosecution.

Claims 21, 23-24 and 26 were rejected as being unpatentable over the combination of Cox, which relates to a slitter used for slitting elastic materials such as rubber; Kolycheck, which relates to an electrostatic dissipating additive (but does not teach, or suggest, any relevance in connection with a rubber slitter, or glass separating tool); Wilhite, which relates to a saw table gauge block that is not suitable for cutting glass; and Bareggi, which relates to a “screwing machine,” which has no relevance to a glass separating tool. The Applicants respectfully submit that these claims should be in condition for allowance at least for the reasons discussed above.

With respect to the obviousness rejections, It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather “some teaching or suggestion in the references to support their use in the particular claimed combination” is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

In *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary

skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988).

In combining Cox with multiple other references, the Office Action has merely picked and chosen among isolated, individual elements of disparate references to re-create the Applicants' claimed invention. There is no teaching or suggestion in these references to support their use in the particular claimed combination. As such, the Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The proposed combination represents "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir. 1983). Thus, at least for these reasons, the Applicants respectfully request reconsideration of the claim rejections.

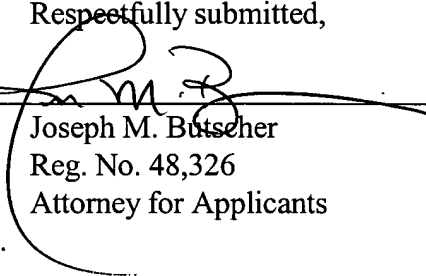
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In light of the above, the Applicants request reconsideration of the application and look forward to working with the Examiner to resolve any remaining issues in the application. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the Applicants. The Commissioner is authorized to charge any necessary fees or credit any overpayment to Applicants' Deposit Account 07-0845.

Respectfully submitted,

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By: _____


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